

**REMARKS**

Entry of the foregoing, and reconsideration and further examination of the subject application, in view of the amendments above and the remarks below, are respectfully requested. /

**Status of Claims**

By the above amendments, claim 1 has been amended to delete extraneous matter that was inadvertently added in the previous version of claim 1. In addition, non-elected claims 22-46, 51-68, and 71-72 have been deleted without prejudice or disclaimer. (Claim 69 was canceled by prior amendment.) Thus, upon entry of the foregoing amendments, claims 1-21, 47-50, and 70 will remain pending in the application. Each of these claims is under consideration.

**Claim Rejections – 35 U.S.C. § 103**

Claims 1, 3-21, and 70 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Swanson (U.S. Patent No. 6,607,621) in view of Shih (U.S. Patent No. 5,891,294). Claims 2 and 47-50 were also rejected under 35 U.S.C. § 103(a) as being unpatentable over Swanson in view of Shih, and further in view of Reed (U.S. Patent No. 3,432,376). For the following reasons, these rejections should be withdrawn.

As correctly noted in the Office Action, Swanson does not disclose or suggest each feature of the present invention, as set forth in representative claim 1. For example, Swanson does not disclose or suggest contacting a stained portion of a substrate with a dry film layer where the stained portion includes a mark, discoloration, or deposit. Swanson only discloses a wall patch to cover holes or cracks in a wall. Col. 2, lines 39-40. There's no mention of using the patch to cover marks, discolorations, or deposits; or the unique problems associated with such stains. Thus, Swanson fails to disclose or suggest each feature of amended claim 1 or its dependent claims.

To remedy this deficiency, the Office Action relies on Shih. However, Shih does not remedy the deficiencies of Swanson because it cannot be properly combined with Swanson. To establish a *prima facie* case of obviousness, there must be some

suggestion or motivation to combine the reference teachings. MPEP § 2143.01 at 2100-129 (Rev. 2, May 2004). Here, there is no requisite suggestion or motivation.

Swanson and Shih are directed to solving different problems. As noted above, Swanson is directed to a wall patch to cover holes or cracks in a wall. In contrast, Shih discloses a stain blocking barrier layer. Shih is directed to solving the problem of stains diffusing onto and through a surface covering. Col. 1, lines 16-20. Shih does not mention covering holes or cracks in a wall, and Swanson does not mention blocking stains. Importantly, there is no disclosure that Swanson's wall patch would be suitable to prevent stain diffusion. Thus, persons skilled in the art would not have been motivated to use the patch of Swanson to cover stains.

Moreover, when covering a hole or crack in a wall as taught by Swanson, persons skilled in the art would unlikely encounter stains, much less the problem of stain diffusion. Underneath the patch of Swanson would simply be a hole or crack, but no stain. Thus, persons skilled in the art would not look to Shih to solve the problem of patching holes or cracks that Swanson identified.

In this regard, the Office Action asserts that "Shih provided the motivation to combine, i.e. providing a stain blocking barrier layer to be incorporated into the surface covering products to prevent diffusion of stains onto the through [sic] the surface covering from a surface or object located directly on or beneath the lower surface." This assertion lacks merit because as mentioned above, below the patch of Swanson would be a hole or a crack, i.e., empty space, rather than a stain. Thus, persons skilled in the art would not have been motivated to put a barrier layer in the patch of Swanson and then use that patch to cover stains.

There is simply no suggestion or motivation to combine the teachings of Swanson with those of Shih, as hypothesized in the Office Action.

Accordingly, there is no *prima facie* case of obviousness. As a result, the rejections under § 103 should be withdrawn.

**Conclusion**

In summary, Applicants believe the application to be in condition for allowance. Accordingly, the Examiner is respectfully requested to reconsider the rejection(s), remove all rejections, and pass the application to issuance.

Respectfully submitted,

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